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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/701,196	04/09/2001	Ullrich Bernecker	H-2867-PCT/U	8711
423	7590	03/19/2004	EXAMINER	
HENKEL CORPORATION THE TRIAD, SUITE 200 2200 RENAISSANCE BLVD. GULPH MILLS, PA 19406			VENKAT, JYOTHSNA A	
			ART UNIT	PAPER NUMBER
			1615	

DATE MAILED: 03/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/701,196	Applicant(s) BERNECKER ET AL.	
	Examiner JYOTHSNA A VENKAT	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16, 18-21, 24-27 and 30-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16, 18-21, 24-27 and 30-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of amendment filed on 12/22/03. The amendment canceled claims 17, 22-23, 28-29 and non-elected claims 35-37. Claims 16, 18-21, 24-27 and 30-34 are pending in the application and the status of the application is as follows:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 16, 18-21, 24-27 and 30-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of admitted art at page 2, lines 10-19 EP'920 and U. S. Patent 5,571, 503('503).

4. The instant application is claiming a composition for treating hair or skin comprising:

1. *biotin*

2. *glycoprotein*

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3. *penetration Auxiliary(claims 22 and 28)*

4. *protein hydrosylate(claims 23and 29)*

5. *plant extract(claim 25)*

6. *panthenol or tocopherol derivative(claim 24)*

7. *film former (claim 26)*

The admitted art teaches the active ingredients 1 and 2 are used in cosmetics. The EP document teaches hair compositions using 1, 2, 6and 7. The EP document does not teach the compositions for the treatment of skin and teaches ingredients 3-5. However the patent '503 teaches cosmetic compositions using 1, 3, 4, 5 and 6. See the abstract, see cols 2-3 and see the claims. The patent suggests the combination of all these ingredients as antipollution complex.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of '920 and combine it with the *various additives* of '503, expecting beneficial effect to the hair or skin. The motivation to use the various additives stems from the teachings of '503 that the compositions provide significant protection of the skin. One of ordinary skill in the art would be motivated to use the additives for treating hair as these components are anti pollutants and when skin or hair is exposed pollutants it results in damage to the skin and hair and using these pollutant complex protects not only the skin but also the hair which is also exposed to pollution. This is a prima facie case of obvious ness.

Response to Arguments

5. Applicant's arguments filed 12/22/03 have been fully considered but they are not persuasive.

Applicants argue that '920 discloses a hair and scalp treatment which contains biotin, glycoprotein, panthenol and a film former and the formulation of '920 requires the presence of vitamin E nicotinate and applicants formulation does not require this component and if one skilled in the art would combine the essential elements of '920 and '503 applicants formulation would not result because of the presence of nicotinic acid derivative.

In response to the above argument, it is the examiners position that applicants are indeed claiming formulation with Vitamin E nicotinate, which belongs to tocopherol derivative. The use of the term " comprising" permits the presence of other ingredients and does not preclude the presence of other ingredients, active or inactive, even in major amounts. Moleculon Research corp., v. CBS, Inc., 793 F. 2d 1261, 229 USPQ 805 (FED. Cir. 1986); In re Baxter, 656 F. 2d 679, 210 USPQ 795, 803 (CCPA 1981).

Absent a showing the criticality of all the components *v a and b together* giving unexpected and superior results commensurate with the scope of the claims, the claims are rendered prima facie obvious over the combination of '920 and '503.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,


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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Thursday, 9:30-7:30:1st and 2nd Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K PAGE can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JYOTHSNA A VENKAT
Primary Examiner
Art Unit 1615
